

**Application No.: 09/847,937****Atty Docket: MKSI 1000-1****REMARKS**

Claims 1-21 are currently pending in this application. Claims 19-21 were previously added.

Claims 8, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-3 and 19 are currently rejected under 35 U.S.C. 102(e) as being anticipated by Kino et al. (U.S. Patent 6,782,403, hereafter "Kino"). Claims 4-7, 8-10, 11-14, 15-16 and 20 are all rejected under 35 U.S.C. 103(a).

**Report of Interview and Request for Three-way Interview**

Applicants appreciate the Examiner's courtesy of a telephonic interview on 11 August 2005. Applicants' general thrust was that neither the Kino reference used as a primary reference in this office action, nor the Lection reference in the last office action was very close at all to the claims, so there must be something worth discussing.

Applicants recounted, consistent with the specification, the adaptation of the SECS protocol to low-speed serial communications and described the difficulty of matching context-setting to context-sensitive messages to produce context-insensitive messages. During the discussion, it became clear that the Examiner was not assigning weight to the "context-" limitations, so Applicants volunteered to identify sections of the application that apply these terms.

During the interview, we also discussed the section 112 rejections. As to claim 8, the Examiner found "compliant" to be difficult to understand. For claims 17 & 18, the Examiner explained that he informally surveyed several colleagues in the art unit regarding how they would understand "applying business logic" and the colleagues were not very definite. We appreciate the explanation and responded with some of the points made below, regarding issuance of patents in classes 707 and 709 that use the term "business logic".

No amendments were offered by Applicants. No agreements were reached, as the Examiner indicated that he does not have signing authority.

**Application No.: 09/847,937****Atty Docket: MKSI 1000-1**

Applicants appreciate the Examiner's offer to conduct a three-way interview. We think that this would be productive, either telephonically or in person. We have calendared a follow-up for one month to call and schedule a three-way interview.

**Rejection Under 35 U.S.C. § 112 of Claims 8, 17 and 18**

The Examiner rejects **claims 8, 17 and 18** under 35 U.S.C. § 112 as failing to particularly point out and distinctly claim.

**Claim 8**

The Examiner argues that **claim 8** is indefinite in use of the phrase "complaint with a SECS standard". The meaning of "SECS standard" is not indefinite to one of ordinary skill, as can be discerned by searching the Internet. Google returns around 200-300 relevant citations for "SECS standard", which is evidence that the phrase has meaning to those of skill in the art, whose perspective is controlling.

The notion of messages being compliant with a standard also is well known. For instance, Google returns about 14,000 hits for "802.11g compliant". Compliant generally means using elements of the technical standard in the way that the standard describes, to comply with the standard. Paragraph [0052] uses the terms "SECS-compliant", "HL7-compliant" and "DIACOM-compliant" in a context that will be readily understood by one of skill in the art.

Therefore, claim 8 should not be rejected under § 112.

**Claims 17 & 18**

The Examiner argues that **claims 17 & 18** is indefinite in use of the phrase "applying business logic". The Examiner acknowledges that "business logic" is a well known term in the business methods art, but argues that it is not in the networking art. Applicants used Lexis (searching "business logic" and network and granted-date aft 2004-01-01) to find out if the Examiner's informal survey of colleagues agrees with the perspective of those of skill in the art. Since January 1, 2004, the PTO has issued at least 58 patents in classification 707 (same as the Kino reference) that use the term "business logic" and "network"; it has issued 48 patents in classification 709 (same as this application) using the same terms. Having traversed the Examiner's assertion of his informal survey results, Applicants specifically request an affidavit supporting the

**Application No.: 09/847,937****Atty Docket: MKSI 1000-1**

Examiner's position. The MPEP § 2144.03, provides guidance as to what more the Examiner must provide:

If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2).

Again, use of a broad term makes a claim broad, not indefinite. MPEP § 2173.04.

Alternatively, we ask, "Why is it an issue that these claims use terms from two areas of art, from both the networking art and the business methods art?" We are not aware of any rule against a claim embracing terminology used in more than one area of art. As Applicants acknowledge that the phrase "applying business logic" is borrowed from business methods art, those reading this prosecution history will be able to understand the meaning of this admittedly "well known term".

Further, the Examiner's Kino reference uses "business application", which appears to mean the same as "business logic". Would referring to "a business application" better satisfy the Examiner?

Therefore, claims 17 & 18 should not be rejected under § 112.

Applicants respectfully submit that the rejection of claims 8, 17 and 18 under § 112 should be withdrawn.

**Rejection Under 35 U.S.C. § 102(e) of Claims 1-3 and 19**

The Examiner rejects **claims 1-3 and 19** under 35 U.S.C. § 102(e) as anticipated by Kino et al. (U.S. Patent No. 6,782,403).

**Claim 1**

**Claim 1** includes the limitations:

*receiving a data stream of structured messages, including context-setting messages and context-sensitive messages, said context-sensitive messages being meaningful only when matched with corresponding context-setting messages, said structured messages having one or more fields adapted to match the context-setting messages with the corresponding context-sensitive messages;*

**Application No.: 09/847,937**

**Atty Docket: MKSI 1000-1**

*tagging the structured messages with XML tags corresponding to the structure of the messages;*

*matching the XML tagged context-setting messages with the corresponding XML tagged context-sensitive messages, utilizing the fields; and*

*generating context-insensitive XML retagged messages, the context-insensitive XML retagged messages having XML tags corresponding to the context of the context-sensitive messages; and*

*outputting the context-insensitive XML retagged messages*

Applicants have tried to, but cannot find any of these limitations in Kino.

As the claims are to be interpreted in light of the specification, we suggest that the Examiner review paragraphs [0010], [0015]-[0026] and [0033]-[0034], which walk through an example of a context-setting and context-sensitive messages, conversion to structure tagged messages and conversion of matched messages to context-insensitive messages. Nothing in the last two office actions mentioned these limitations. (A three-way interview and discussion of these terms and the example in the specification may be helpful in giving appropriate weight to these limitations.)

Kino is an extensive reference, 90 pages long. The Examiner refers only to Embodiment 11, cols. 51-53, and to col. 52, lines 25-65 in particular. For ease of reference, we reproduce those lines on the following page. All that we can find in Kino's Embodiment 11 is a first format to XML to HTML data translation. The Examiner has not cited any particular lines as referring to "*context-setting messages and context-sensitive messages*" and we do not find any in lines 34-44, which discuss the first format to XML translation. Nor has the Examiner made a *prima facie* case that the reference teaches tagging with XML tags corresponding to the structure of the message, nor of matching context-setting and context-sensitive messages, nor of generating context insensitive messages. Even the output of Kino is HTML, not XML.

Application No.: 09/847,937

Atty Docket: MKSI 1000-1

25 In this embodiment, it is assumed that a user of the user  
interface A (20) updates the contents of data stored in the  
data base A (24) through the business application A (21), and  
the contents of the data base B (44) corresponding to the  
updated data is to be updated through the application inter-  
mediary unit B (59) and the business application B (41),  
30 which is similar to the first embodiment.

Data being updated in the data base A (24) is inputted to  
the data format conversion unit (33) in the same manner as  
that discussed in the first embodiment. The data format  
35 conversion unit (33) converts the data format of the updated  
data into the data exchange format based on the data format  
conversion rule stored in the data format conversion rule  
memory A (34). A data format using XML (extensible  
Markup Language) may be set, for example, as the data  
40 exchange format in the data format conversion rule stored in  
the data format conversion rule memory A (34). In that case,  
the converted data through XML is inputted to the second  
data format conversion rule memory (70) as data in an XML  
based data format.

45 The second data format conversion unit (70) further  
assigns conversion to the inputted data based on the data  
format conversion rule stored in the data format conversion  
rule memory A2 (71). It is assumed in this embodiment that  
the second data format conversion rule memory A2 (71)  
50 stores the data format conversion rule to be used for con-  
verting the XML based data format into an HTML (Hyper  
Text Markup Language) based data format and outputting  
converted data into an HTML format file. An output of the  
data format conversion external output unit (72) is outputted  
55 as the HTML format file. According to this specific example,  
the outputted HTML format file becomes available imme-  
diately for display on an external display unit through a  
browser.

60 The second data format conversion rule memory A2 (71)  
may store the data conversion rule to be used for converting  
data into a different XML based data format. In that case, the  
data format conversion external output unit (72) outputs  
XML format data which is different from the XML format  
65 data outputted from the data format conversion unit (33).

**Application No.: 09/847,937****Atty Docket: MKSI 1000-1**

Because Kino does not include any of the elements of claim 1, this claim should be allowable over Kino. Because the rejection follows a second search, after the initial art-based rejections were withdrawn, it is requested that the claim be allowed at this time.

**Claims 2-3 & 19**

**Claims 2-3 & 19** should be allowable over Kino for at least the same reasons as claim 1, from which they depend.

**Rejection Under 35 U.S.C. § 103(a) of Claims 4-7**

The Examiner rejects **claims 4-7** under 35 U.S.C. § 103(a) as unpatentable over Kino et al. (U.S. Patent No. 6,782,403) in view of Gary, Jr. et al. (U.S. Patent No. 6,604,115).

**Claims 4 & 6**

**Claim 4** includes the limitations:

the context-setting messages include report definition messages and report trigger messages, said report definition messages including a report identifier and one or more variable identifiers and said report trigger messages including an event identifier and one or more report identifiers;

the context-sensitive messages include report messages generated upon occurrence of an event associated with the event identifier, said report messages including the report identifier and variable values but not the variable identifiers; and

generating XML retagged messages includes generating XML tags corresponding to the variable identifiers and reporting the variable values

**Claim 6** is similar, with report definitions triggered by report demand messages, instead of events. These limitations are not found in Kino in view of Gary.

Applicants cannot see the relevance of the passages cited from Gary to these context-setting and context sensitive message limitations. The passages cited are:

Application No.: 09/847,937

Atty Docket: MKSI 1000-1

4	5
<p>tem faults and failures. A service user, which includes third party or off-site service users or customer based service users, will be able to review error logs from any and/or all devices or software applications of CVIS 10. Access to service user interface 70 may be under password control. In an exemplary embodiment, a service technician utilizing service user interface 70 will be locked out from reviewing any patient specific data. Further, a service technician utilizing service user interface 70 will be able to install network licensed feature additions. Further still, in an exemplary embodiment, a service technician utilizing service user interface 70 will be able to remotely access all service tools and data on site as well as remotely through any of a variety of communications networks including, but not limited to, the world wide web.</p>	<p>ODBC formats. Database 100 may maintain a log of all transactions and an error log of failed transactions. Further, database 100 may be configured to recover transactions which failed.</p>

Even if a combination of references were properly motivated, Kino lacks the elements that the Examiner proposed to find in the primary reference, and Gary lacks the elements needed from the secondary reference.

Applicants do not understand how the Examiner proposes to combine the references. Are errors resulting from failed Kino data translations to be placed in a Gary error log database? How would that relate to the claims? Even though the combination appears futile and unproductive, it is important to understand why it is improper, as well.

The Examiner argues that "It would be obvious to one of ordinary skill in the art to review error logs from devices via XML because XML is a standard format that an administrator can use to collect, display and report data." That statement, relevant or not (we cannot connect it to the claim), is not enough to support a § 103(a) rejection. As we explained in response to the last office action, MPEP § 2143.01 sets forth a fundamental requirement that the Examiner rely on some evidentiary quality suggestion to produce the claimed combination:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). *See also In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual

Application No.: 09/847,937

Atty Docket: MKSI 1000-1

findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

This section of the MPEP cites the no-longer recent case *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an Examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to the Examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

Under *In re Lee*, it is not enough for the Examiner to announce that a particular result would be obvious and rely on his own perspective, derived from the application in the absence of any evidentiary quality teaching or suggestion, as motivation to combine two references. No evidentiary quality support for combining references is found in the Examiner's statement of what would result from combining the references.



**Application No.: 09/847,937****Atty Docket: MKSI 1000-1**

The Examiner's announcement that a combination could add to Kino what it admittedly lacks, using the claim as a blueprint or roadmap (20-20 hindsight), is impermissible. 2-5 Chisum on Patents § 5.03 [2][c] n. 29 (2005 Lexis version); e.g. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.' "). This is not an evidentiary quality suggestion to combine the references to address a problem that neither reference frames or suggests be solved.

Therefore, claims 4 & 6 should be allowable over Kino in view of Gary.

#### Claims 5 & 7

Claims 5 & 7 should be allowable over Kino in view of Gary for at least the same reasons as claims 1, 4 and 6, from which they depend.

#### Rejection Under 35 U.S.C. § 103(a) of Claims 8-10

The Examiner rejects claims 8-10 under 35 U.S.C. § 103(a) as unpatentable over Kino et al. (U.S. Patent No. 6,782,403) in view of purportedly admitted prior art.

Submission of a document, such as the SECS standard, does not create any admitted prior art. MPEP § 2129 (IV) at 3100-73, *citing*, 37 CFR 1.97(h) (no admission even of materiality). Accordingly, the rejection should be withdrawn and restated based on § 102(a) or (b), if the Examiner considers those statutory sections applicable.

The Examiner argues that "Kino should be easily modifiable by one of ordinary skill in the art to work with ANY PROTOCOL." That statement, true or not (we disagree), is not enough to support a § 103(a) rejection. Again, there is a fundamental requirement that the Examiner rely on some evidentiary quality suggestion to produce the claimed combination. MPEP § 2143.01; *In re Lee*, 277 F.3d at 1343-44 (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); Under *In re Lee*, it is not enough for the Examiner to announce that something could easily be done and rely on his own

**Application No.: 09/847,937****Atty Docket: MKSI 1000-1**

announcement as motivation to combine two references. No evidentiary quality support for combining references is found in this rejection.

The Examiner's announcement that a combination could easily be made to add Kino what it admittedly lacks, using the claim as a blueprint (20-20 hindsight), is impermissible. *See references cited above.* This is not an evidentiary quality suggestion to combine the references to address a problem that neither reference frames or suggests be solved.

Applicants respectfully submit that claims 8-10 should be allowable over Kino in view of purportedly admitted prior art.

**Rejection Under 35 U.S.C. § 103(a) of Claims 11-14**

The Examiner rejects **claims 11-14** under 35 U.S.C. § 103(a) as unpatentable over Kino in view of purportedly admitted prior art in further view of Gary. Applicants respectfully submit that claims 11-14 should be allowable over Kino in view of purportedly admitted prior art in further view of Gary for at least the same reasons as claims 1 & 8, from which they depend, and 4-7, which they parallel. Moreover, the three-way combination of references is less supported than either of the two-way combinations with Kino.

**Rejection Under 35 U.S.C. § 103(a) of Claims 15-16 and 20**

The Examiner rejects **claims 15-16 and 20** under 35 U.S.C. § 103(a) as unpatentable over Kino in view of Lo et al. (U.S. Patent No. 6,854,120).

**Claim 15**

**Claim 15** includes the limitations:

*tagging the structured, non-XML messages with XML tags corresponding to the structure of the messages;*

*interpreting content and the structure of the structure tagged message to identify fields of the structure tagged messages;*

*generating field tagged messages from the structure tagged messages, said field tagged messages having XML tags corresponding to the identified fields of the structure tagged messages; and*

*checking the field tagged messages for data format and data validity  
checking utilizing tools adapted to XML formatted messages*

**Application No.: 09/847,937****Atty Docket: MKSI 1000-1**

These limitations are enough different than the limitations of claim 1 to require that the Examiner address them directly. This is especially true because it is a stretch to try to apply Kino to claim 1.

Therefore, claim 15 should be allowable over Kino in view of Lo, alternatively because the Examiner did not make a *prima facie* case by calling them similar to claim 1 or for the same reasons as claim 1.

**Claims 16 & 20**

**Claims 16 & 20** should be allowable over Kino in view of Lo for at least the same reasons as claim 15, from which they depend.

**Rejection Under 35 U.S.C. § 103(a) of Claims 17 & 18**

The Examiner rejects **claims 17 & 18** under 35 U.S.C. § 103(a) as unpatentable over Kino in view of Lo et al. (U.S. Patent No. 6,854,120). Applicants respectfully submit that claims 17 & 18 should be allowable over Kino in view of Lo for at least the same reasons as claim 15, to which the examiner compares them.

**Rejection Under 35 U.S.C. § 103(a) of Claims 20 & 21**

The Examiner rejects **claims 20 & 21** under 35 U.S.C. § 103(a) as unpatentable over Kino in view of Lo et al. (U.S. Patent No. 6,854,120). Applicants respectfully submit that claims 20 & 21 should be allowable over Kino in view of Lo for at least the same reasons as claims 15 & 17, from which they depend.

**Application No.: 09/847,937**

**Atty Docket: MKSI 1000-1**

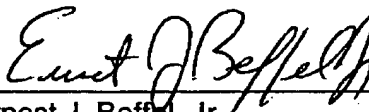
**CONCLUSION**

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,

Dated: 11 August 2005

  
Ernest J. Beffel, Jr.  
Registration No. 43,489

HAYNES BEFFEL & WOLFELD LLP  
P.O. Box 366  
Half Moon Bay, CA 94019  
Telephone: (650) 712-0340  
Facsimile: (650) 712-0263